

**Remarks/Arguments:**

Claims 1-30 are pending in the application. Claims 1-16 are withdrawn from consideration as drawn to a non-elected invention. Applicants thank the Examiner for the opportunity afforded their undersigned representative, Frank Tise, to discuss by telephone on May 15, 2008 a potential amendment to clarify the meaning of the term "alloy" as used in the claims. The discussion included consideration of amendment language specifically reciting that the named metal in an alloy is present in an amount greater than that of every other element in the alloy. It was agreed that such recitation would be within the teachings of the specification and would not introduce new matter, as confirmed in the Examiner Interview Summary Record. Claims 17 and 26 are amended herewith accordingly, as supported in the specification on page 4 at lines 13-18.

**35 U.S.C. § 103**

Claims 17-30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Rivera et al. (US 6,126,997; "Rivera") in view of Blum et al. (Materials Science and Engineering A319-321 (2001) 735-740), hereinafter "Blum."

The Office Action states that Rivera teaches all of the instant claim limitations, with the exception that it does not teach the use of both an organo-functional silane AND a group IV-B element in combination with a polymer blend having a plurality of carboxylic and hydroxyl groups, but that Rivera does teach using these individually and that combining them would therefore be *prima facie* obvious. However, Applicants point out that Rivera does not teach or suggest the use of his formulations on metals in general, but only on magnesium or magnesium alloys. Magnesium alloys are defined by Rivera in column 3 at lines 17-19 as alloys in which "...magnesium has the highest content of any other element or a content equal to the highest element."

The examiner relies upon Blum to establish that AZ91 and AM60 (which are disclosed by Rivera) are both "aluminum-containing alloys." However, these are NOT aluminum alloys in which aluminum is present in an amount greater than that of every other element in the alloy, as presently claimed. Rather, Rivera is directed ONLY to magnesium and magnesium alloys, the definition of which excludes aluminum alloys as the present invention defines them. Indeed, AZ91 contains only a minor amount of aluminum, only 8.9%, and AM60 contains only 6.1% aluminum. The balance is essentially magnesium. See Blum

Table 1. Thus Rivera does not disclose or suggest alloys in which aluminum is present in an amount greater than that of every other element in the alloy, as presently claimed.

It is well known in the art that various metal treatment compositions exist, and that what works on one metal frequently does not work on another. Rivera mentions only magnesium/alloys as being suitable for treatment with his compositions, and does not teach or suggest their suitability for use on any other substrate. Therefore, Rivera neither teaches nor suggests all of the claim elements, and a *prima facie* case of obviousness has not been presented. Accordingly, the rejection should be withdrawn.

#### Obviousness-Type Double Patenting

Claims 17-30 are rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 11-15 of Rivera in view of Blum. Applicants respectfully traverse these rejections as follows, beginning by providing two passages from the MPEP.

"...a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection under 35 U.S.C. 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent."<sup>1</sup> [emphasis added]

"Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art."

<sup>2</sup> [emphasis added]

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<sup>1</sup> MPEP 804 III


<sup>2</sup> MPEP 804 B. 1.

Rivera, and specifically claims 11-15 thereof, does not teach or suggest the use of his compositions for treating aluminum, iron, zinc, or their alloys in which these elements are present in an amount greater than that of every other element. In fact, utility is not taught for any substrate other than magnesium or alloys thereof in which magnesium is not exceeded by any other element. Such a surface is not included within the scope of the present claims. Thus, the Office Action has not provided the claim element relating to the metal surfaces currently recited, and therefore has not set forth the "reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent." Accordingly, Applicants submit that the rejection of claims 17-30 has been overcome.

Conclusion

For the above reasons, Applicants submit that the rejections have been overcome, and request reconsideration and allowance of claims 17-30. Applicants invite the examiner to contact their undersigned representative, Frank Tise, if it appears that this would expedite examination.

Respectfully submitted,



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